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10/622,511	07/21/2003	Osamu Shimamura	50195-376	3790

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McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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LEE, CYNTHIA K

ART UNIT	PAPER NUMBER
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1745

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/622,511

Applicant(s)

SHIMAMURA ET AL.

Examiner

Cynthia Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/2006 has been entered.

**DETAILED ACTION**

This Office Action is responsive to the amendment filed on 11/13/2006. Claims 1-3, 6-16, and 18 are pending. Claim 1 has been amended and claims 4, 5, and 17 have been canceled. Claim 18 is withdrawn from further consideration as being drawn to a non-elected invention.

The instant claims are rejected under new grounds of rejections and thus, claims 1-3 and 6-16 are rejected as stated herein below.

***Election/Restrictions***

Applicant asserts that upon the allowance of the automobile cell claims, Applicants respectfully request rejoinder, examination, and allowance of the method of manufacturing an automobile cell, in accordance with MPEP 821.04.

In response, MPEP 821.04(b) states that:

"Where claims directed to a product and to a process of making and/or using the product are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or a process. See MPEP § 806.05(f) and

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§ 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 821 through § 821.03. However, if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must depend from or otherwise require all the limitations of an allowable product claim for that process invention to be rejoined."

The Examiner notes that the method claim has not been amended to require all the limitations of the product claim. The method claim will not be rejoined unless it depends from the allowable claim or requires all the limitations of the product claim.

### ***Claims Analysis***

Regarding the preamble "automobile" in claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987). See MPEP 2114.

### ***Claim Objection***

Claims 2, 6, 7, and 10 are objected to because it is unclear whether the subject matter within the parentheses is positively recited or not. Correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 claims that the cell is "wound" and claim 1 claims a "stack-type cell." It is unclear how a cell can be stack-type (as claimed in claim 1) and be wound at the same time. Clarification is required. For the purposes of prosecution, claim 13 was interpreted to claim a wound cell.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibuya (US 6291098) in view of Murai (US 6444355), Takami (US 6544682), and Yata (US 6902847).

Shibuya discloses a thin type cell (or a stack-type cell) comprising a positive electrode having a positive electrode active substance layer, a negative electrode having a negative electrode active substance layer, and a separator interposed between the positive electrode and the negative electrode, the positive electrode, the negative electrode and the separator being stacked in a stack direction to allow the positive electrode and the negative electrode, opposing to the positive electrode via the separator. See Fig. 1 and 3. The cell out sheath is made from a laminate film

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composed of polymer and metal and welded to gas-tightly encapsulate the electric power generating element inside the cell outer sheath such that the cell is formed in a flat shape. It further consists a positive electrode terminal lead electrically conductive with the positive electrode and sandwiched between welded portions and extending to an outside of the cell outer sheath. The same applied for the negative electrode terminal lead.

Shibuya discloses that the anode comprised coating the active material onto copper foil with a total thickness of 200  $\mu\text{m}$  (8:1-30). Shibuya does not disclose the thickness of the nickel foil current collector. However, Takami discloses of using a copper foil current collector for the negative electrode with a thickness of 10  $\mu\text{m}$ . It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Shibuya's negative electrode current collector with a thickness of 10  $\mu\text{m}$  because both Shibuya's and Takami's are wound batteries and for the benefit of keeping the thickness relatively low to keep the resistivity low.

Shibuya discloses that the cathode with an active material coated on an aluminum net current collector has a thickness of 130  $\mu\text{m}$ . Shibuya does not disclose the dimensions of the aluminum net current collector, but Murai teaches that the current collector comprises aluminum net is  $\sim 30\mu\text{m}$  in thickness (7:10-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Shibuya's current collector of  $\sim 30\text{ }\mu\text{m}$  because it's commonly known in the art to use an aluminum current collector with this dimension to conduct current in a wound battery.

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Although Shibuya does not disclose the thickness of the separator and the electrolyte, adding the thickness of the cell components, which include the sheath (89  $\mu\text{m}$ ), positive electrode (130  $\mu\text{m}$ ), negative electrode (200  $\mu\text{m}$ ), positive terminal (110  $\mu\text{m}$ ), negative terminal (110  $\mu\text{m}$ ), and dividing by the thickness of the positive and negative active material layer yields no greater than  $\sim 4$ , which is well below 80. See 6:55-67-7:1-15. Thus, when one were to include the separator and the electrolyte thickness, the ratio would not be greater than 80. However, absent specific thickness of the separator and the electrolyte, it is obvious that one of ordinary skill in the art would form the separator and the electrolyte of comparable dimensions as the electrode and the terminal and thus, yielding a ratio not greater than 80.

Shibuya discloses that the ratio of the thickness of the cell divided by the thickness of the active substances is 3.64, and not equal to or greater than 10 and equal to or less than 80 (applicant's claim 1). However, Takami teaches that the positive electrode layer and the negative electrode layer each has a thickness between 10  $\mu\text{m}$  and 150  $\mu\text{m}$ . Takami teaches that where the thickness of the electrode layer is set to fall within a range of between 10  $\mu\text{m}$  and 150  $\mu\text{m}$ , it is possible to improve the large discharge characteristics and the cycle life (4:25-35, 5:35-45). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Shibuya's and Murai's battery with the electrode layer thickness between 10 and 150  $\mu\text{m}$  for the benefit of improving the cycle life of the battery, as taught by Takami. Making Shibuya's battery as modified by Murai with the active material thickness as

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taught by Takami would yield a ratio of the thickness of the cell by the thickness of the active substances as high as 36.4, thus meeting claim 1.

Shibuya modified by Takami and Murai results in the thickness of the anode active substance of 190 um and the thickness of the cathode substance of 100 um. Shibuya modified by Takami and Murai does not disclose that at least one of the thickness of the active substance layer is equal to or greater than 20 um and equal to or less than 80 um (applicant's claim 10). However, Takami teaches that where the thickness of the electrode layer is set to fall within a range of between 10 um and 150 um, it is possible to improve the large discharge characteristics and the cycle life (4:25-35, 5:35-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the thickness of the electrode active layers, hence varying the distance from the surface of the electrode to the separator, for the benefit of improving the cycle life of the battery.

Takami discloses that the thickness of the active material affects discharge characteristics, thus clearly teaching that the active material thickness is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05. It has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et. al., 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412. In the case where the claimed ranges "overlap or lie inside ranges disclosed by



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the prior art" a prima facie case of obviousness exists, see MPEP 2144.05. Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See MPEP 2144.05.

The dimensions of the sheath are 8 cm by 10 cm (applicant's claim 2). The discharge current of the cell is 0.25 mA/cm<sup>2</sup> for 10 weeks or 190 cm<sup>2</sup>/Ah (See fig. 16 and 9:5-10) (applicant's claim 3). The terminal leads are made from carbon, nickel, aluminum, copper, tungsten, stainless steel, iron, silver, gold, alloys thereof (4:1-5) (applicant's claim 9). Shibuya discloses that the cell outer sheath is made from a pair of laminate films (6:55-65) (applicant's claim 11).

Shibuya does not disclose that the value obtained by dividing a thickness of the electrode terminal lead along the stack direction by a sum of a total thickness of the electrode current collector in a cell is equal to or greater than 0.4 and equal to or less than 2.0 for positive and negative electrode (applicant's claim 1). However, Shibuya discloses that the thickness of each electrode terminal is 110  $\mu$ m. The Shibuya modified by Murai would result in ~ 30  $\mu$ m for the aluminum net (as stated above). Shibuya modified by Takami would result in ~10  $\mu$ m for the copper foil (as stated above). Yata teaches a stack-type cell wherein several cells are stacked (fig 2). The Examiner notes that stacking multiple cells together is common in the battery art to increase the capacity. One of ordinary skill in the art would be motivated to stack several unit cells together, as taught by Yata, to increase the cell capacity, thus yielding

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a ratio as claimed by the applicants. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect several unit cells for the benefit of increasing the cell capacity, thus possessing the ratio of thickness of the terminal and the total of current collectors as claimed by the applicants. Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See MPEP 2144.05.

The cathode terminal dimensions are 5mm by 3mm (applicant's claims 6 and 7). Further, Shibuya discloses that the width and the length of the electrode terminals are matched to the shape of the cell. Preferably, the width and the length are selected so that the voltage generated across both ends of the electrode terminals used as cells will be not higher than 1/100 of the nominal voltage of the cell (5:25-30). Further, for preventing short-circuiting, the thickness of the electrode terminal may be set so as to be smaller than that of the sheath (4:49-51). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the electrode terminal dimensions in accordance with the sheath dimensions for the benefit of enclosing the terminal in the sheath. Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See MPEP 2144.05.

Shibuya's positive and negative electrode terminals extend to the outside from opposing sides of the cell outer sheath (applicant's claim 8).

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Shibuya does not disclose that the cell outer sheath is made from one sheet (applicant's claim 12). Shibuya discloses that the cell outer sheath is made from two sheets. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cell sheath from one sheet instead of two sheets for the benefit of easier sealing.

Shibuya does not explicitly disclose that more than one cell is connected in series or parallel (applicant's claim 14). Shibuya discloses only one cell. However, this limitation substantially encompasses the two electrical connections known in the electrical field. Further, it's commonly known in the art to join several cells together for the benefit of increasing the output voltage or current. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add several cells and connect them in series or in parallel, depending on if the voltage or the current needs to be increased.

It is commonly practiced in the art that a bus bar is used to connect electrode terminal leads (applicant's claim 15). It is further noted that when more than one cell is connected in series or on parallel, they are either stacked or positioned side by side (applicant's claim 16).

The limitation "automobile" has been considered, but it adds nothing to the patentability of the present claims because it is recited in the preamble. Additionally, Shibuya's cell (flat type cell) has substantially the same configuration of applicant's cell (stack-type cell). It also recites an intended use for the cell.

Shibuya as modified by Murai do not disclose that the cell is wound (applicant's claim 13). However, Takami discloses that the cell is wound. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to wind the cell components for the benefits of creating a higher energy density cell.

### ***Response to Arguments***

Applicant's arguments filed 11/13/2006 have been fully considered but they are not persuasive.

*Applicant asserts that Takami and Murai are directed to wound cells while Shibuya is directed to a stack-type cell, and thus one of ordinary skill in the art would not look towards the wound cell teaching of Murai and Takami (pg 11).*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Since Shibuya, Murai, and Takami are all in the field of applicant's endeavor and one type of cell is not taught away from another type of cell, the Examiner notes that the combination is proper.

*Applicant asserts that there is no suggestion in Shibuya and Murai to modify the thickness of the cell to form the thickness as claimed by the Applicants (pg 12).*

The Examiner notes that it is common practice in the battery art to stack multiple cells to vary the size and capacity of the cell for its intended application. Thus, the aspect ratio of the thickness of the cell by the sum of the thickness of the electrode active substance layer and the aspect ratio of the thickness of the terminal lead to the sum of the total thickness of the current collector are variable depending on the size and power requirements of the desired application. Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See MPEP 2144.05.

*Applicant asserts unexpected improvements wherein the electrode terminal leads and current collectors meet the claimed limitations (pg 14).*

The Examiner notes Tables 1-3 of the present specification demonstrate improvements, but not unexpected improvements. Having reviewed the showing in the specification (pgs 48-50), the examiner has determined that the applicants have not demonstrated that the claimed subject matter as a whole imparts unexpected results (with a showing of only one comparative example). The appellants have the burden of showing that the claimed subject matter imparts unexpected results. In re Klosak, 455 F.2d 1077, 1080, USPQ (CCPA 1972). “[I]t is incumbent upon appellants to submit clear and convincing evidence to support their allegation of unexpected property.” In re Heyna, 360 F.2d 222, 228, 149 USPQ 692, 697 (CCPA 1966). Should Applicants assert that data in Tables 1-3 impart unexpected results, the Applicants are advised to

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specifically point out in the Specification the experiments and results that demonstrate unexpected results.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's trainer, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ckl

Cynthia Lee

Patent Examiner

  
SUSY TSANG-FOSTER  
PRIMARY EXAMINER